

**REMARKS**

The present application relates to inbred maize line PH7JD. Claims 2-73 have been canceled. Claims 17-20, 31-33, 36, and 44-46 were previously canceled in the Amendment filed June 13, 2003 and claims 45 and 46 were previously canceled in the Amendment of October 28, 2002. New claims 74-103 have been added. No new matter has been added by the present amendment. Applicants respectfully request consideration of the following remarks.

**Detailed Action*****A. Claim and Specification Objections***

Applicants acknowledge the rejections of claims 3, 5, 12, 22, 24, 30-33, 40-44, and 47-49 under 35 U.S.C. § 112, second paragraph are withdrawn in light of the claim amendments or cancellations. The rejection of claims 13, 17, 32, 33, 36, 41, and 43 under 35 U.S.C. §§ 102(e)/103(a) are acknowledged as withdrawn, in light of the claim amendments and further consideration.

***B. Newly Submitted Claims***

Applicants acknowledge the addition of new claims 74 through 103, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and revised via telephone on August 25, 2003 and September 2, 2003 and per the meeting of supervisory and primary Examiners on September 11, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items noted in the claims faxed by Examiner Fox can be found within the specification for *Bacillus thuringiensis* on page 28; for imidazolinone, sulfonylurea, glyphosate, glufosinate, L-phosphinothricin, triazine, and benzonitrile on pages 31-32; for phytase on page 32; for stearyl-ACP desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase and starch branching enzyme on pages 32-33; and for waxy starch and increased amylose starch on pages 21 and 33. In addition, Applicants have amended the specification to clarify the deposit language. No new matter has been added by the present amendment. Entry of this Amendment After Final and approval of the changes is respectfully requested.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 43 and 50-73 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 43 stands rejected as the Examiner states there is insufficient antecedent basis for the recitation for the recitation "The further PH7JD progeny maize plants or parts thereof".

Applicants have canceled claim 43, thus alleviating this rejection.

The Examiner rejects claims 50, 55, 60, 64, and 69 as indefinite for the recitation "A method of making a PH7JD plant" in line 1 of the claims.

Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicants have now canceled claims 50, 55, 60, 64, and 69, thereby rendering this rejection moot.

Claims 53, 58, 62, 67, and 71 stand rejected as indefinite for the recitation "comprising the method of claim 52(or 50 or 55 or 60 or 64 or 69) and further comprising crossing the PH7JD maize plant of claim 52 with a second maize plant".

Applicants have canceled claims 53, 58, 62, 67, and 71, alleviating this rejection.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 9-16, 28-30, 34, 35, 37-39, 41-43, and 47-49 remain and claims 50-73 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons of record in the Office Action mailed January 13, 2003.

The Applicants traverse the rejection. Although not acceding to the Examiner's rejection, to expedite prosecution Applicants have canceled claims 2-73, thereby rendering this rejection moot. Applicants have added new claims 74-103, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and August 25, 2003 and September 2, 2003 and per the meeting of supervisory and primary Examiners on September

11, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification as described *supra*.

Claims 3 and 50-73 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons of record in the Office Action mailed January 13, 2003.

Applicants respectfully traverse this rejection. The Applicants have provided assurance that at least 2500 seeds of inbred maize line PH7JD have been deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02). Although not acceding to the Examiner's rejection, to expedite prosecution Applicants have canceled claims 3 and 50-73, thereby rendering this rejection moot. Applicants have added new claims 74-103, as disclosed *supra*. It is respectfully submitted that Applicants' claims are sufficiently described and enabled by the specification.

In addition, Applicants assert that the introgression of mutant genes and transgenes is easily, routinely and extensively practiced by those of ordinary skill in the art. Backcrossing has been known since the 1920's and, because of its predictability, is the method preferred by commercial plant breeders to introduce transgenes into already developed and tested material. An example of how one of ordinary skill in the art can transfer a gene conferring a qualitative trait into a variety through backcrossing is demonstrated by the fact that the commercial market now distributes a multitude of products produced in this manner. Such conversion lines are easily developed without undue experimentation.

Further, the Applicants would like to reiterate that a patent application "need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986); MPEP § 601.

It is understood by those of skill in the art that backcross conversions are routinely produced and do not represent a substantial change to a variety. The World Seed Organization, on its web site, writes, "The concept of an essentially derived variety was introduced into the 1991 Act of the UPOV Convention in order to avoid plagiarism through mutation, multiple backcrossing and to fill the gap between Plant Breeder's Rights and patents." As determined by the UPOV Convention, "essentially derived varieties may be obtained for example by the selection

of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering".

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections to claims 3, 9-16, 28-30, 34, 35, 37-39, 41-43, 47-49 and 50-73 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicants acknowledge that claims 1, 2, 4-8, 21-27, and 40 are allowed.

Applicants have amended the claims as suggested by Examiner David Fox and Supervisory Patent Examiner Amy Nelson as allowable. Applicants submit the claims place the application in condition for allowance and comply with all requirements of form set forth in previous office actions.

### Conclusion

In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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